
COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.

OCTOBER TERM, 1906.

PATENT APPEAL DOCKET No. 397.

IN THE MATTER
OF
APPLICATION OF NATIONAL
PHONOGRAPH COMPANY,
SERIAL NO. 6678.

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APPEAL FROM THE
COMMISSIONER OF
PATENTS.

BRIEF FOR APPELLANT.

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Court of Appeals of the District of Columbia,

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Appeal from the Commissioner of Patents.

BRIEF FOR APPELLANT.

This is an appeal from the decision of the Commissioner of Patents (Rec., p. 12) affirming the action of the Primary Examiner (Rec., p. 5) refusing to register as a trade-mark the word "Standard" as applied to Phonographs. The Commissioner held that:

"the word 'Standard' has a descriptive meaning in its application to goods of the class for which its registration is sought by the applicant. The consequent right of others to use the same freely on such goods defeats the applicant's claim to trade-mark rights thereon, and such claim is none the less certainly defeated because the applicant has contended that he only applies the word to machines of inferior design and which are not in any sense standards."

An application for a rehearing was made to the Commissioner and was accompanied by affidavits (Rec., pp. 14-17) from which it appeared that the trade-mark was used arbitrarily and not descript-

ively, but the application for rehearing was denied by the Acting Commissioner (Rec., p. 13), who held that:

"the word 'Standard' is believed to have a descriptive meaning in its application to phonographs, notwithstanding the facts set forth in the affidavits offered with this petition."

The reasons of appeal are:

"1. That the Commissioner of Patents erred in refusing to register the trade-mark covered by the said application.

"2. That the Commissioner of Patents erred in holding that the word 'Standard' has a descriptive meaning in its application to goods of the class for which its registration is sought by the applicant.

"3. That the Commissioner of Patents erred in being controlled in his holding by the definition of the word 'Standard' in the Century Dictionary.

"4. That the Commissioner of Patents erred in not holding that the question of the descriptiveness of the word 'Standard' as applied to phonographs is a question of fact."

A Valid Trade-Mark Should Not Be Descriptive of the Goods with Which It Is Used, Nor of the Character or Quality of Such Goods, Although It May Be Suggestive Thereof.

One of the latest text books on the subject of trade-marks says:

"The general proposition is therefore well established, that words which are merely descriptive of the character, qualities or composition of an article cannot be monopolized as trade-marks. * * * It is no objection to a word used as a trade-mark that it is *suggestive of the qualities or grade of the article* upon which it is used, if not actually descriptive thereof" (Paul on Trade-marks, Sec. 63).

And again:

"On the ground that they cannot be lawful trade-marks at common law, descriptive words are refused registration by the Patent Office. Words, however, that are merely sug-

gestive of some quality or characteristic of the article to which they are applied may be common law trade-marks, and, therefore, entitled to registration" (Paul on Trade-marks, Sec. 341).

Such expressions, therefore, as "Bromo-Soda Mint" (86 O. G., 631); "Apple and Honey" (87 O. G., 179); "Ever-ready" (87 O. G., 1782); "Purity" (83 O. G., 295); and, "Better Than Mother's" (83 O. G., 1207), have been held by the Patent Office to be descriptive, and refused registration, since they plainly indicated character or quality. Instances of trade-marks which have been considered by the courts and held invalid as being descriptive, are the following:

"Iron Bitters," as applied to a medicinal preparation (see *Brown Chemical Company vs. Meyer*, 139 U. S., 540);

"Perry's Medicated Mexican Balm," as applied to medicines (see *Perry vs. Truefitt*, 6 Beav., 66);

"Nourishing Stout," as applied to beer (see *Raggott vs. Findlater*, L. R., 17 Eq., 29);

"Dessicated Cod-fish," as applied to dried cod-fish (see *Town vs. Stetson*, 3 Abb. Pr., 218);

"Compressed Yeast," as applied to the ordinary yeast cakes (see *Fleischmann vs. Newman*, 16 N. Y. St. Rep., 794);

"Fireproof Oil," as applied to illuminating oils (see *Scott vs. Standard Oil Company*, 106 Ala., 475);

"Headache Wafers" as applied to medicines (see *Gessler vs. Grieb*, 80 Wis., 21);

"Instantaneous," as applied to a preparation of tapioca (see *Bennett vs. McKinley*, 65 Fed., 505);

"Straight Cut," as applied to cigarettes (see *Ginter vs. Kinney Tobacco Company*, 12 Fed., 782).

On the other hand, words which are not truly descriptive, although they may in a measure suggest character or quality, have been registered in the Patent Office as valid trade-marks and *have been invariably sustained by the Courts*. Thus, in *Sleepy Eye Milling Company vs. C. F. Blanke Tea & Coffee Company*, 85 O. G., 905, Mr. Commissioner DUELL held that the word "Koffio" as applied to imitation coffee "may be suggestive, but it is not descriptive," and in *Ex parte Peek*, 96 O. G., 425, the present Commissioner, in considering the registrability of the word "Waukeasy" as a trademark for a corn cure, said:

"The Examiner holds that the mark is a 'descriptive and advertising term, indicative of a quality or characteristic of the medicine' in that it conveys the idea that by using it a person may walk easily. The appellant contends, on the other hand, that even if the mark conveys the idea that by the use of the corn-cure, walking is made easy, it is not descriptive of the composition or quality of the article and is registrable. He maintains that it cannot properly be held to be descriptive merely because it suggests a remote result which may be brought about by its use and cites in support of his contention, the decision of the Court in *O'Rourke vs. Central City Soap Company*, 35 O. G., 875, wherein the word 'Anti-Washboard' was sustained as a trade-mark for soap. This view is believed to be correct. The word 'Waukeasy' is perhaps suggestive, but it is not descriptive of the composition or qualities of the article, or the direct result produced by its use. The result or condition suggested by the word is so remote from the article to which it is applied that it cannot be held to be one of those descriptive terms which any person has the right to use in describing similar articles, and which therefore cannot be exclusively appropriated by one person. The mark would be recognized by purchasers as being arbitrary and fanciful."

Instances of trade-marks which have been held valid by the courts and which are similar in character to the mark sought to be registered herein, are the following:

"*Eureka*," as applied to fertilizers; see *Alleghany Fertilizer Co. vs. Woodside*, Fed. Cases No. 206.

"*Excelsior*," as applied to ranges; see *Sheppard vs. Stuart*, 13 Phila., 117.

"*Kaiser*," as applied to beer; see *Baltz Brewing Company vs. Kaiserbrauerie, Beck & Company*, 74 Fed., 222.

"*Pride*," as applied to cigars; see *Hier vs. Abrahams*, 82 N. Y., 519.

"*Cream*," as applied to baking powder; see *Price Baking Powder Company vs. Fyfe*, 45 Fed., 799.

"*Star*," as applied to shirts; see *Hutchinson vs. Blumberg*, 51 Fed., 829.

"*Royal*," as applied to baking powder; see *Royal Baking Powder Company vs. Raymond*, 70 Fed., 376, and 85 Fed., 231.

"Ideal," as applied to fountain pens; see *Waterman vs. Shipman*, 130 N. Y., 301.

"Champion," as applied to flour; see *Atlantic Milling Company vs. Robinson*, 20 Fed., 217.

"Marvel," as applied to flour; see *Listman Mill Company vs. Listman Milling Company*, 88 Wis., 334.

As a matter of fact, in the law of trade-marks, no proposition is more firmly established than that purely descriptive words cannot be monopolized for use in connection with articles with respect to whose character or quality they necessarily apply, unless it be the proposition that words which are merely suggestive of character or quality can be properly appropriated. In fact, the new Trademark Act expressly provides that no mark which consists "merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act" (Sec. 5). The questions which are then presented on this appeal are these:

Is the word "Standard" when applied to phonographs an arbitrary or possibly suggestive word, or is it a descriptive word?

Does it accurately *describe* the character or quality of a phonograph?

Does it merely *suggest* the character or quality of a phonograph?

Or when applied to phonographs, is it purely arbitrary?

The Commissioner appears to base his decision largely on the definition of the word "Standard," as given in the Century Dictionary, namely: "Serving as a standard or authority; regarded as a type or model; hence, of the highest order; of great worth or excellence." Admitting the correctness of this definition, it is not seen how the particular type of phonograph with which the word is used in the trade can be considered a standard or authority, or as a type or model. The appellant makes eighteen different styles of instruments, and to each type a particular word or name is applied (Gilmore's affidavit, p. 14). Many other types of talking machines are made by its principal competitors, the Columbia Phonograph Company and the Victor Talking Machine Company. It would be impossible to say that any of these types could be regarded as a standard or authority, and hence could be *described* by the word "Standard." The particular class of phonographs with which the trade-mark is used by appellant is one employing a cylindrical

record with the feed screw behind the mandrel and operated by a spring motor. Why should such a machine be regarded as a standard or authority, or as a type or model for all phonographs, any more than a machine employing a disk record, or one having no feed screw, or one with the feed screw at the end of a mandrel, or one operated by an electric motor? If there were only one type of phonograph in existence the word might very properly be applied thereto, but since there are at least fifty types manufactured by appellant and its competitors it is not seen how the word can, as the Commissioner says, have "a descriptive meaning in its application to goods of the class for which registration is sought." The authorities referred to by the Commissioner do not sustain him.

Ex parte Brown (Endorsement August 13, 1879), has not, so far, as we have been able to find, ever been reported. It is, however, briefly referred to in *Newton's Digest of Trademarks*, from which it would appear that registration of the word "Standard" was refused by Acting Commissioner Doolittle on the ground that the word, "according to Webster, means having a fixed or permanent value and is, therefore, descriptive in character." There is no record from which we can ascertain what class of goods the mark in question was to be used with, and it may therefore be safely assumed that the mark was purely descriptive.

In *Ex parte Cohn*, 16 O. G., 680, C. D. 1879, p. 225, it was held that the word and letter "Standard A" as a trademark for cigars were descriptive, as the mark would "obviously indicate that the cigars to which it shall be applied are in quality of the highest standard." Undoubtedly, however, in this case the descriptiveness of the mark consisted of the letter "A," rather than the word "Standard," as it is well settled under the authorities that letters cannot be appropriated as trade-marks when they merely indicate among other things, the quality of the articles with which they are used. See *Amoskeag Mfg. Company vs. Spear*, 2 Sadf. (N. Y.), 599; *Candee vs. Deere*, 15 Ill., 439; *Amoskeag Mfg. Company vs. Trainer*, 101 U. S., 51; *Royal Baking Powder Company vs. Sherrell*, 93 N. Y., 331; *Avery vs. Meikle*, 81 Ky., 73; *Lawrence Mfg. Company vs. Tennessee Mfg. Company*, 138 U. S., 537; *Smith and Davis Mfg. Company vs. Smith*, 89 Fed., 486; *Dennison Mfg. Company vs. Thomas Mfg. Company*, 94 Fed., 651.

In *Ex parte Standard Furniture Company*, 54 M. S. Dec., 67, the registrability of the word "Standard" as a trademark for desks was considered. The Assistant Commissioner, after pointing out

that merely suggestive words could be registered as trademarks, said :

"Applying this test to the case in hand it is thought that if the definitions of the word 'Standard' given by the Examiner, viz:

'That which is capable of satisfying certain defined conditions fixed by the proper authority';

'That which is established as a rule or model by the authority of public opinion or by custom or by general consent; that which serves as a test or measure';

were the only meanings of that word, it might perhaps stand the test and be a lawful trademark, but there is another sense in which that word may be, and is, actually used."

The Assistant Commissioner then refers to the special definition of the word, given by the Century Dictionary, and on which the Office in the present case appears to principally rely; namely, "of the highest order; of great worth or excellence", and therefore refused registration. We believe that in this decision the Office fell into the same error as in the present case, and we expect to show that this special definition is an unusual one not sanctioned by other authority, and cannot be regarded as the ordinary meaning of the word as would appeal to the public at large in a descriptive sense.

In *Ex parte Standard Fashion Company*, 89 O. G., 189; 1899, C. D., 187, also referred to by the Commissioner, the trade-mark consisted of "the representation of a standard or flag and a number of stars distributed about the standard or flag." The only question considered by Mr. Commissioner Duell, was whether certain accessory features were properly a part of the mark. He did not decide, as the present Commissioner seems to think, that the word "Standard" was not a lawful trade-mark. In fact, the point was not even considered by the former Commissioner, since the word was accepted by him as synonymous with *flag*.

The final decision relied upon by the Commissioner is *Computing Scale Company vs. Standard Computing Scale Company, Ltd.*, 118 Fed., 865, by the Circuit Court of Appeals for the Sixth Circuit. In that case, the court (p. 971) said :

"The case is even weaker for the word "standard." It is a descriptive word, and has been used by the complainant

only as a descriptive word. This is shown by the names of scales heretofore set out, taken from complainant's catalogue and is used to designate not a scale made by a particular maker, but a particular class of scales, *supported on standards*, in distinction to 'swinging,' 'spring-balance,' or 'cylinder' scales. In short, 'standard' stands for a particular sub-class of computing scale, and was a term used only to indicate that class, and was never in any sense a word signifying the maker."

Of course, the Court was clearly right in this position. If there were, in fact, swinging scales and spring-balance scales and cylinder scales and standard scales, the word "Standard" as applied to scales, could no more be appropriated as an exclusive trade-mark than could the word "Swinging", or "Spring-balance" or "Cylinder". A device adapted to be supported on standards could only be aptly described as a standard device, but this is not true in the present case, because phonographs are not supported on standards and no one claims that the word in any way describes the mechanical construction of the goods. In the same decision, the Court further called attention to the fact that the word "'Standard' is also a word commonly employed in the scale trade, as indicative of excellence and adherence to the *standard of weights and measures fixed by the government.*" Here, again, the word was capable of use only in a descriptive sense, as one might speak of a *standard* quart measure, or of a *standard* yard stick, which necessarily refer to the fixed and definite standards determined by the government. But no one pretends that there is any fixed or definite standard of phonographs, so that the word is not capable of being used descriptively in the sense of a computing scale.

**The Special Definition by the Century Dictionary is
Not Supported by Authority and the Word in
that Sense Would Not Appeal to the General
Public, but at Best Would Only Appeal to Lexi-
cographers and the Erudite.**

Not only do the authorities on which the Commissioner relies fail to support the conclusion that the word "Standard" is not a lawful trade-mark, or may not, as applied to certain articles be a law

ful trade-mark, except possibly the case of *Ex parte Standard Furniture Company*, but it is thought there was error in following the special definition as given by the Century Dictionary. We do not concede that "Standard" in its ordinary sense means "of the highest order; of great worth and excellence" except possibly in its adherence to a fixed and government standard. A book, for instance, might be written on the subject of radium, and if it were the only publication extant, it would, no doubt, be a standard work on the subject. It would, however, be absurd to say that such a work would be *necessarily* of the highest order, or of great worth or excellence, because as compared to other scientific books, it might be of a low order and without worth or excellence. The definition in the Century Dictionary does not coincide with the definitions in other dictionaries of equal authority. For instance, in the Imperial Dictionary, the word as an adjective is defined as, "Having a permanent quality; capable of satisfying certain conditions fixed by competent authority; fixed, settled."

By Webster (Edition, 1902) the word as a noun is defined as :

"That which is established by authority, as a rule for the measure of quantity, extent, value or quality; especially the original specimen, weight or measure sanctioned by government as the standard pound, gallon or yard.

"That which is established as a rule or model by authority, custom or general consent; criterion, test."

The same authority thus defines the word as an adjective :

"Being, affording or according with a standard for comparison and judgment; as *standard* time, *standard* weights and measures, a *standard* authority as to nautical terms, *standard* gold or silver. Hence, having a recognized and permanent value; as *standard* works in history, *standard* authors."

By Worcester (Edition 1891) the word as a noun is defined as :

"That by which quantity or quality is fixed, regulated, estimated or valued; a test or rule of measure or quality; criterion."

And, as an adjective as :

"Being a standard in quantity, measure, or quality."

From these definitions, it would appear that the essential characteristics of the word in a descriptive sense is fixity or permanence, and hence when used in connection with articles which are of varying quality and whose types are not permanent, the cannot possibly be used in a descriptive sense.

The definition given by the Century Dictionary is not recognized by such standard lexicographers as Webster and Worcester, and hence obviously would not appeal descriptively to the general public. Many other special definitions are given by the Century Dictionary, some of which it is believed are of the most limited application. For instance, the word is defined in the following ways:

1. The particular ensign of an army.
2. A large flag.
3. A feather suggesting a standard by its shape or position.
4. A standard bearer.
5. A standard of weight and measure.
6. In coinage, the proportion of weight and fine metal and alloy, established by authority.
7. That which is set up as a unit of reference.
8. A grade, a rank; specifically in British Elementary Schools, one of the grades or degrees of attainment according to which the pupils are classified.
9. Serving as a standard or authority, etc.
10. To bring into conformity with a standard.
11. A post, pillar, column, mill-post; trophy.
12. A tree or shrub which stands alone.
13. A shrub, as a rose, grafted on an upright stem.
14. A stand or frame; a horse.
15. A large chest.
16. A standing cup, a large drinking cup.
17. The chief dish at a meal.
18. A suit; a set.
19. One who stands or continues in a place.
20. Standing upright; specifically in horticulture, standing alone.

Of these multitude of definitions, the Commissioner has selected a special one where the word is used as meaning of great worth or excellence, and regards that meaning as the descriptive sense in which the word would be accepted by the public when applied to phonographs. The special meaning, however, not being sanctioned by common usage or by such good authority as Webster and Worcester, would not it is believed appeal to the average person any more than would the other unusual definitions given by the Century Dictionary. On this point, it might be mentioned that if all the definitions of the Century Dictionary are taken as the authority on which the Patent Office may base its decisions, the Office would not have registered many of the trade marks which have been sustained by the courts. For instance, the word "Ideal" which was sustained as a trade mark for fountain pens (*Waterman vs. Shipman*, 130 N. Y., 301, *Supra*) is defined by the Century Dictionary as:

"Conforming completely to a standard of perfection; perfect;"

and the word "Champion" which was sustained as a trademark for flour (*Atlantic Milling Company vs. Robinson*, 20 Fed., 217) is defined as:

"First among all competitors or contestants; as a champion oarsman. Hence 2—By extension, of the first rank or highest excellence in any respect; unexcelled."

The Decision of the Commissioner from Which the Appeal is Taken, Admits the Non-Descriptive Character of the Mark as Applied to the Particular Goods.

The application (Rec., p. 4) states that:

"The class of merchandise to which the trademark is appropriated is talking machines, and the particular description of goods comprised in said class upon which said trademark is used is phonographs."

The decision of the Commissioner appears to be that, while appellant only applies the word to machines of inferior design and which are not in any sense standards, yet, since the word "has a descriptive meaning in its application to goods of the class for which its registration is sought by the applicant," such registration should be refused. From what has been already said, it is not seen how the word can as a matter of fact have a descriptive meaning in its applications to phonographs specifically, or talking machines in general, but since the Commissioner admits that the phonographs to which the word is applied are not in any sense standards, it should, we submit, follow that registration should not be denied for the mark as employed by appellant. Certainly, if the phonographs with which the word is used are not in any sense standards, the word cannot be used descriptively. This appears from the syllabus of the Commissioner's decision, as the same is reported in 124 O. G. 2901, as follows:

"Where the word is descriptive as applied to goods of the character for which registration is sought, *though not descriptive of the particular articles upon which the applicant uses it*, registration should be refused."

To be Descriptive and Hence Incapable of Registration, the Mark Should be Plainly Explanatory of Character or Quality. If it Suggests Different Ideas to Different Persons it Cannot be Descriptive, but, at Best, is Merely Suggestive.

The several authorities which are referred to in the record show that the word "Standard" cannot have any descriptive meaning in the art, but on the contrary, the idea suggested by the word is in every case different. For instance, in *Ex parte Cohn, supra*, Commissioner Paine was of the opinion that the term "will obviously indicate that the cigars to which it shall be applied are in quality of the highest standard." In *Ex parte Brown, supra*, Acting Commissioner Doolittle considered that the word meant "having a fixed or permanent value." In *Ex parte Standard Furniture Company*, the special definition of the Century Dictionary is followed. In *Ex parte Standard Fashion Company, supra*, Commissioner Duell, regarded the word as synonymous with flag. In the *Century Dictionary*,

that, while design and word "has a place for registration is not seen meaning in machines phonographs standards, it be denied the phonograph standards, is from the reported in

ary, one of the many definitions of the word is "of the highest order; of great worth and excellence." In *Computing Scale Company vs. Standard Computing Scale Company, supra*, the word is considered as referring to a machine supported on standards; and also to a device designed to conform to the government standard of weights or measures.

In the present case, neither the Commissioner, nor the Examiner pretends to express any opinion as to the meaning of the word, but each insists that it is descriptive. We ask how can a word be descriptive of a particular article if to different minds, it means

1. Of the highest standard,
2. Having a fixed or permanent value,
3. A flag,
4. Of the highest order; of great worth and excellence;
5. An apparatus supported by standards, and
6. Something that conforms to the government standard of weights and measures?

Certainly a word having so many meanings and conveying so many different impressions to so many different minds, cannot be said to be descriptive, but must be suggestive or else purely arbitrary. Thus to one mind, it would suggest a phonograph of highest standard or order; to another mind it would suggest a phonograph of a fixed and permanent value; to another mind, a phonograph resembling a flag; to another mind a phonograph of highest worth and excellence; to another mind a phonograph mounted on standards, and to another mind a phonograph conforming to a government standard. Accepting the special meanings of the word given by the Century Dictionary, the mental impressions might be further continued. Thus, to a soldier, it would suggest a phonograph resembling an ensign or feather; to a coiner, a phonograph made of a standard alloy; to a British school boy, a phonograph adapted for school use; to horticulturist, a phonograph resembling a tree or shrub; to a carpenter, a phonograph resembling a standard or frame, or a horse or large chest, etc. Since none of these suggestions is in fact realized in practice, no other conclusion can be reached than that the word is not only non-descriptive, and non-suggestive, but is purely arbitrary, and the affidavits submitted in the case (Rec., pp. 14-17) show that the word is so regarded in the

Registratory of Different Descrip-

record show meaning in word is in *supra*, Com- l obviously e in quality Acting Com- wing a fixed e Company. allowed. In oner Duell, ury Diction-

trade. Thus, Mr. Gilmore, the President of the appellant corporation, says :

"It has from time to time placed upon the market new types of phonographs to which it has applied fanciful words for use as trade-marks. Such words have been arbitrarily selected with a view to distinguishing the phonographs sold by said applicant from other phonographs or talking machines on the market. Among the words so adopted were the words 'Gem,' 'Home,' 'Standard' and 'Triumph.'"

Mr. Devaga, a large jobber of phonographs in New York City, says in his affidavit :

"No one in the phonograph business would ever think of referring to this particular machine as a standard among phonographs, and although the machine is spoken of as the 'Standard' phonograph, it is well understood that this is merely a fanciful word arbitrarily selected as a trade-name for the machine in question (Rec., pp. 15, 16).

To the same effect see affidavit of Rapke (Rec., p. 17).

The Word may be Descriptive as Applied to Certain Articles and Suggestive as Applied to Others. In One Case it Is and in the Other it is Not Capable of Appropriation and Registration as a Proper Trademark.

We admit, of course, that in the *Computing Scale Case*, the word "Standard" was purely descriptive, and descriptive in a double sense. Because the word, however, is descriptive of a machine that is supported on standards, it is obviously not descriptive of a machine that has no standards. Because the word is descriptive of a machine that conforms to a government standard, it does not follow that the word is descriptive when applied to machines for which there is no government, or other, standard. Instructive cases on this point are those involving the trademark "Carroms" as applied to games or game-boards. The games in question are played upon

a flat rectangular board, having a rim around its periphery and formed with pockets in its corners, the idea being to shoot wooden rings into said pockets. It was urged that the word "Carroms" was purely descriptive of such a game, because in playing the game the rings would necessarily "carrom" from one to another, as with billiard balls. The trademark was considered by the Circuit Court of Appeals for the Seventh Circuit, in *Williams et al. vs. Mitchell et al.*, 106 Fed., 168, the court saying:

"The cross appellants insist that the court erred in holding the word 'Carrom' to be a descriptive word which could not be made a trade-mark for a game board. The word 'Carrom' or 'Carom' is without doubt descriptive of a certain game at billiards, and is defined to be 'the hitting of two or three balls in succession by the cue ball from one stroke of the cue.' The word is not, however, descriptive of the game boards before us, or the games played thereon, whether those of the complainants or of the defendants; for, while a carrom is possible, it is no part of the game, which consists in pocketing the disks, rings, or balls. * * * It is the case of the use of a descriptive word in a non-descriptive sense. * * * If the first clause of the decree here complained of were necessary or essential to that which follows, we should think the finding incorrect, because while the word 'Carrom' may be descriptive of a game at billiards, it is not descriptive of the game in question, and the complainants' board coming to be known by the designation of the 'Carrom Board,' or the 'Carrom Game,' the defendants may not rightfully apply that name to their game as a designation or name of the game, although they have a right as the court below decreed to use the word in descriptive portions of advertisements, so long as they used them in a purely and properly descriptive sense."

The trade-mark was again considered by Judge TOWNSEND in *Ludington Novelty Company vs. Leonard*, 119 Fed., 937, in which the Court said:

"Defendant's claim that the word 'Carrom' is descriptive and therefore cannot be a proper subject for a trademark. Complainant relies upon the decision of the Circuit

Court of Appeals for the Seventh Circuit, in *Williams vs. Mitchell*, 45 C. C. A., 265; 106 Fed., 168. In that opinion it is held that the word 'Carrom' is a descriptive word in billiards, but is not properly a descriptive word in a game to be played with disks where the object is, not to strike two separate disks or balls but to drive a disk into a pocket.
* * * The use of the word by the Mitchell-Bradley Company, closely approximated, its use in the strict sense in billiards. It was used by Horsman as descriptive, and not as the name of a game. The popular sense, admitted by Haskell and Bostwick, appears to have been considered in the *Williams vs. Mitchell* Case, where the court says, 'for, while a carrom is possible, it is no part of the game, which consists in pocketing the disks, rings or balls.' So in the games in question, where the object is to pocket the disks or to place them in some particular position, and this is accomplished by striking other disks against them, 'Carroms,' in the popular sense cited, may be used by causing a disk to strike against and glance away from the rim before striking the disk intended to be pocketed, but this not sufficient to make the word 'Carrom' descriptive of the game, or to prevent the application of the reasoning adopted in *Williams vs. Mitchell, supra*. Upon consideration of the whole evidence, it seems reasonably clear that this word is not so descriptive of complainant's game-board that it could not fairly be adopted as a trade-mark."

It seems impossible to reconcile the reasoning of the courts in the *Carroms Cases* with the decision of the Patent Office in the present case. Even if it be admitted that the word "Standard" is descriptive as applied to certain talking machines, the same admission was made in the *Carroms Cases*, where it was held that the word was descriptive as applied to certain games. If, in the *Carroms Cases*, notwithstanding this admission, the word was regarded as a perfectly proper trade-mark when applied non-descriptively to other games, the admission of the Patent Office that the word is "not descriptive of the particular articles upon which the applicant uses it," would appear to dispose of the case.

Whether the Word as Applied to Certain Articles is Descriptive Depends upon the Special Facts. The Facts of this Case Show that the Word is Used Arbitrarily and Certainly not Descriptively.

The affidavits make it perfectly plain that the word "Standard" as applied by appellant to a certain type of machine, was selected arbitrarily and is so regarded in the trade. Mr. Gilmore in his affidavit, says (Rec., p. 14) :

"The word 'Standard' is not descriptive of phonographs ; that is to say, 'Standard Phonograph' does not indicate to one in the trade, a phonograph of any particular type, quality or character. It is impossible for this word to mean 'serving as a standard or authority', because there is no standard or authority among instruments of this character. A large number of talking machines or phonographs are on the market in this country, at least four or five different makes, and most of the makers put out quite a large number of different types of machines. The National Phonograph Company puts out eighteen different types, each of which differs in some respects from all others ; for instance, some of the phonographs are operated by spring motors, others by direct and alternating current electric motors. The various types also differ as the means adopted for regulating the speed of the mandrel, the means for supporting the outer end of the mandrel, the general arrangement of the various parts, etc. Among all of these various types of the National Phonograph Company and other makers not one to deponent's knowledge serves as a standard or authority or is referred to as a type or model, or is of the highest order among phonographs. The particular machine to which the word 'Standard' has been applied by the National Phonograph Company as a trademark, is a machine, the list price of which is \$20.00 and is operated by a spring motor. The National Phonograph Company makes other phonographs operated by spring motors and adapted to be used in the same way as the machine referred to which are of greater excellence than the 'Standard' machine, and sell for higher prices ; for instance, the phonograph known as the 'Home' is listed at \$30, and

that known as the 'Triumph' is listed at \$50.00. This fact is believed to show clearly that the National Phonograph Company does not use the word 'Standard' as meaning 'of the highest order' or 'serving as a standard or authority', because the 'Triumph' and 'Home' machines are superior to the 'Standard' in many ways, especially in mechanical features which are expensive to produce and which therefore necessitate the listing of these machines at higher prices. I do not know of any person, firm, or corporation engaged in the sale of phonographs who describes any particular machine as being a standard in this respect and if such an advertisement should appear I would not know what it meant although I have been engaged in this business for the last ten years, because there is no instrument of this character to which the word could be appropriately applied as a descriptive term."

Obviously, whether a word is used descriptively or not, must depend upon the special circumstances of each case, because we have seen from the *Curroms Cases*, that although the trade-mark involved was descriptive as applied to a game of billiards, it was not found not to be descriptive as applied to another game.

In *Bennett vs. McKinley*, 65 Fed., 505, the Circuit Court of Appeals for the Second Circuit held that the word "Instantaneous" as applied to tapioca, which could be prepared instantaneously, was not a proper trade-mark. They intimated, however, that the word might be used with perfect propriety in a non-descriptive sense, and said:

"Whether a word claimed as a trade-mark is available, because it is a fanciful or arbitrary name, or whether it is obnoxious to the objection of being descriptive, must depend upon the circumstances of each case. The word which would be fanciful or arbitrary when applied to one article may be descriptive when applied to another. If it is so apt and legitimately significant of some quality of the article to which it is sought to be applied that its exclusive concession to one person would tend to restrict others from properly describing their own similar articles, it cannot be the subject of a monopoly. On the other hand, if it is merely suggestive or is figurative only, it may be a good trade-mark notwithstanding it is also indirectly or remotely descriptive."

Perhaps, however, it is not necessary for us to point to any special authority in support of this proposition, since the Commissioner, in his decision, admits that the word is "not descriptive of the particular articles upon which the applicant uses it."

In Cases of Doubt the Mark Should Always be Registered. To Refuse Registration may Result in Irreparable Commercial Loss Without any Consequent Gain to the Public.

A few practical considerations may be presented to the Court which it is thought will be conclusive of this case. In the first place, it is to be noted that the new Trademark Act provides solely for registration, and no monopoly is granted thereby, which has not been fully recognized for many years and is now recognized by the common law. The only practical benefit of the Act is to confer jurisdiction on the Federal Courts in suits involving registered trademarks, in those limited cases where the same jurisdiction is not offered by reason of diversity of citizenship or for other reasons. Therefore, the government has very little to give to an applicant in exchange for the registration fee. It should also be noted that there is nothing in the law of trademarks that is in any way analogous to the grant of a mere "paper patent." A trademark represents a practical accomplishment and it can only be registered when it is actually used. Finally, it is to be noted that the new Act (Section 6) fully protects the public in providing that:

"Any person who believes he would be damaged by the registration of a mark, may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office within thirty days after the publication of the mark sought to be registered, etc."

In the present case, therefore, should the decision of the Commissioner be reversed, the mark would have to be published in the "Official Gazette" and its registration can be opposed by any one who may believe himself entitled to use the word "Standard" in connection with phonographs. It would seem in view of these considerations, that the attitude of the Patent Office towards applicants for the registration of trade-marks should be extremely liberal, and that all doubts should be resolved in the applicant's favor. To refuse registration in a case like that here presented would do the

applicant irreparable harm and work serious public injury, *for the reason that such action is prejudicial to the extension of our trade in foreign countries.* It ought to be the object of the government wherever possible, to assist its citizens in the extension of their foreign trade, and it certainly ought never to be the object of the government, unless some very good public reason appears therefor, to stand in the way of such an extension of trade. In fact, for years it has been the practice of the State Department to publish reports of its Consuls dealing with foreign trade and pointing out the great advantages of American competition. Now, the Court is probably acquainted with the fact that the trade-mark laws of the world are divided into two classes, namely, declaratory and attributive laws. Under the former, of which that of the United States is an example, the registration of a trademark is merely *prima facie* evidence of ownership. See *Greeley on Foreign Patent and Trade-mark Laws* (Washington, 1899, Section 145). Under attributive laws, "the registrant is the owner of the exclusive right to the mark, and while his registration may be canceled for a number of causes which may arise during the term for which it is registered, his right to the mark is absolute, so long as it remains on the register. * * * The first applicant is entitled to registration and the right to the exclusive use of the mark even against a prior user" (*Greeley, Supra*, Section 146). The provision for the cancelation of the registration, referred to by the text writer above, applies only to the German law, and does not apply to other attributive laws, and particularly the law of Cuba. Under the Cuban Trademark Law, any one can register a trademark and by that fact alone becomes the owner of the exclusive rights thereunder, and as such, can prevent the true owner of the mark from using the same in Cuba. This piracy of trademarks is by no means an imaginary evil, but it is a real menace to the development of American foreign trade. Thus, Mr. Greeley, in his valuable book devotes an entire section to this subject. He says:

"This usurpation of marks known to be in use in a foreign country and recognized there as the distinctive marks of producers or traders who have earned a high reputation for their goods and made their marks valuable, has been carried to such an extent in certain foreign countries as to seriously hamper the originators of the marks in their efforts to extend their foreign trade. No matter how long the originator of a mark has enjoyed the exclusive right to it, or how ex-

tensive may have been his use of it in his own country, even though the reputation of the goods bearing his mark may have extended far beyond his country, if he has failed in any foreign country in which registration is attributable of the right to the mark, to apply for registration before the usurper of the mark applies, he cannot export goods bearing his mark to that country, except by making terms with the usurper. He is absolutely without remedy and can place his goods on the market in that country, if at all, only on such conditions as the registrant may choose to dictate. This usurpation of known marks has affected especially owners of marks located in countries in which, as in the United States, the right to the mark is acquired by use. Relying on the fact of their ownership acquired by use and not realizing that in foreign countries registration, which in their own country may not be necessary to protect their rights, is absolutely necessary, they have, in many cases delayed to apply for registration abroad, and by their delay have given an opportunity to the usurper to take advantage of the foreign patent (*sic*) laws to deprive them of valuable rights to which they may be justly entitled and which might have been secured by diligence in applying for registration."

Greeley, Supra, Section 151.

Mr. Greeley (Section 168) further says:

"In countries in which registration is attributable of property in the mark, right to the mark as between rival claimants is determined absolutely by priority of application for registration. Such countries are Argentine Republic, Bolivia, Brazil, Chili, Costa Rica, Denmark, Finland, Germany, Guatemala, Japan, Norway, Paraguay, Peru, Serbia, Spain, Sweden, Uruguay and Venezuela."

To this list, may be added Cuba, in which country applicant is anxious to extend its trade, but fears to do so under conditions which exist in this case. But the court will probably ask, why is it, if this danger exists, that the applicant does not register the mark in those countries in which it seeks to extend its trade and in which there may be attributable trade-mark laws? The answer is that in many of these countries, *registration of a trademark can be effected by a*

foreigner, only after he has first registered his mark in his own country. Thus, of the countries having attributive trademark laws mentioned by Mr. Greeley, it is necessary in Brazil, Denmark, Finland, Germany, Norway, Peru, Spain, Sweden and Venezuela to file with the application for registration a certified copy of the trademark certificate obtained in the applicant's home country. This is also true as to Cuba; while as to Bolivia, Costa Rica and Japan, we have been unable to ascertain whether it is true or not. But the court will see that as to a very extensive field in which a valuable foreign trade might be developed, an American manufacturer would hesitate to extend his commercial operations until he had first registered his trademark therein, and that he would be prevented from securing such registration if denied registration in this country. So far as the new Trademark Act permits our manufacturers to take advantage of its direct benefits, it is quite unimportant; their rights in trademark can be just as effectively protected by the common law. But, in so far as the new Act, by allowing an American manufacturer to obtain a Federal registration of his mark, permits him thereby to obtain registration in foreign countries, having attributive trade-mark laws, the Act is of great value. For these reasons, we believe that in the present case, where to say the least, much can be said in support of the trade-mark, every possible consideration should be waived, in order that the appellant and other manufacturers similarly situated, may be placed in position to extend their foreign trade. If the Patent Office is to take an illiberal position on the subject of trade-marks, the injury which will be done cannot be calculated; and, it is not believed that Congress in conferring upon the Commissioner the right to refuse registration, intended that that right should be exercised except in the clearest kind of a case, or where the protection of the public required it, and certainly not in a case where every real consideration was opposed to it.

Conclusion.

It is believed that the decision of the Commissioner should be reversed.

FRANK L. DYER,
For Appellant National Phonograph Company.
Orange, N. J., November 10, 1906.

[31010]